

REMARKS

The claims pending in this application are 1 and 3 – 13. Claim 2 has been canceled.

Claim 1 has been amended to reflect that the particle size should be greater than 400 microns and that the claimed composition is a fluid. Claim 1 has also been amended to add the hydrocarbon element of claim 2.

Claims 3 – 9 have been amended to claim a drilling fluid.

Claims 6 and 9 have been amended to delete the words “at least.”

Claims 10 and 11 have been amended to reflect that the particles should be greater than 400 microns in diameter.

THE §112 REJECTION

The Examiner rejected claim 6 and 9 under 35 U.S.C. §112 first paragraph as lacking enablement. The claim called for rubber particles which could expand to at least 140% of their original size but the specification only taught up to 140% expansion. Claim 6 and 9 have been amended to delete the word “at least” and now conform with the specification. Applicant respectfully requests that the rejection be withdrawn.

The Examiner next rejected claims 1 – 9 under 35 U.S.C. §112 second paragraph as indefinite. The Examiner believes that the claims more properly describe a drilling fluid, not a drilling fluid additive. The claims have been amended as suggested by the Examiner. Applicant respectfully requests that the Examiner withdraw his rejection.

THE §102 REJECTION

The Examiner has rejected claims 1 – 13 under 35 U.S.C. §102(b) as anticipated by Wood. Applicant respectfully submits that the claims as amended are not anticipated.

To anticipate a claim under 35 U.S.C. §102, a reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. §102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. §2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

The 35 U.S.C. §102 rejection of record fails to establish a 35 U.S.C. §102 rejection in accordance with the foregoing requirements.

As noted by the Examiner, Wood teaches the use of crushed rubber particles ranging up to 400 microns. The claims now call for crushed greater than 400 microns. Thus Wood does not teach the range now claimed in this application. Given the failure to teach this limitation of the claims, Wood can not anticipate the claims. Applicant respectfully requests that the Examiner withdraw his rejection under 35 U.S.C. §102(b).

THE PROPOSED §103(a) REJECTION

The Examiner noted that should applicant amend the present claims to limit the particle sizes to greater than 400 microns, he would reject such claims under 35 U.S.C. §103(a) as unpatentable over Wood. Applicant respectfully submits that such a rejection would be in error.

To establish a *prima facie* case of obviousness, three basic criteria must be met. See M.P.E.P. §2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. To meet this first requirement the examiner must explain why one skilled in the art would look to a particular set of references and why one skilled in the art would be motivated to make the combination suggested by the examiner. *In re Rouffett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998); *in re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicant respectfully asserts that the rejections of record do not meet the foregoing requirements. Accordingly, Applicant traverses the 35 U.S.C §103 rejections of record.

Wood teaches the use of crumb rubber particles with a size of up to 400 microns. While the examiner is correct in his evaluation of the MPEP, he ignores the plain teaching of Wood which is to use small (<400 micron particles) rather than large particles (See paragraph 19). This is confirmed by the arguments made by Wood in the prosecution of his prior application when he specifically argued that his invention was directed to particles of less

than 400 microns (See Ex. A.) *See, ArthroCare Corp. v. Smith & Nephew, Inc.* 406 F.3d 1365, 1371 (Fed. Cir. 2005) (Prosecution history consulted to determine teachings of a reference.) This is a clear teaching of the patent and its prosecution history away from the use of larger particle sizes. This rebuts the examiner's case of prima facie obviousness.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02901US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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